



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

FOLEY & LARDNER LLP
3000 K ST. NW
SUITE 500
WASHINGTON DC 20007

MAILED
NOV 08 2010
OFFICE OF PETITIONS

In re Patent No. 7186495 : DECISION ON REQUEST
Maeda et al. : FOR
Issue Date: 03/06/2007 : RECONSIDERATION OF
Application No. 09/750116 : PATENT TERM ADJUSTMENT
Filed: 12/29/2000 : and
Atty Docket No. : NOTICE OF INTENT TO ISSUE
NEC99P156-MS : CERTIFICATE OF CORRECTION

This is a decision on the petition filed on RESPONSE TO JUNE 2010 DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT, filed on July 6, 2010, which is being treated as a request for reconsideration under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand four hundred eleven days (1411) days. For the reasons stated below, the petition is treated as a petition requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted, by one thousand two hundred sixty (1260) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand two hundred sixty (1260) days is **GRANTED to the extent indicated**.

Patentee asserts that the 204 day period of reduction for applicant delay should be removed. Specifically, patentee notes that the decision mailed on January 23, 2007 stated that this period of delay was in error and should be removed. As such, patentee is correct, and the 204 day period of applicant delay will be removed.

Patentees again argue that a 1075 period starting on the day after the date four months from the date of filing a reply on March 31, 2003, to the mailing of the notice of allowance on July 10, 2006, should be entered. Specifically, petitioners state that the Letter Regarding Suspension mailed on June 20, 2003, is not an action under 35 USC 132 pursuant to 37 CFR 1.703(a)(3) in that it does not constitute a rejection, objection, or requirement, and did not set a time for prosecuting the application under 35 USC 133.

Patentees' contentions have been considered, but their arguments in support thereof have not been found persuasive.

35 USC 154(b)(1)(A)(ii) provides:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to —

...
(ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;

Accordingly, 37 CFR 1.702(a)(2) states, in pertinent part:

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

...
(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

In this instance, there was no examination delay within the meaning of 35 USC 154(b)(1)(A)(ii) and 37 CFR 1.702(a)(2). The reply under 35 U.S.C. 132 was filed on March 31, 2003. The Letter Regarding Suspension mailed June 20, 2003, was mailed in response to and within four months of, the filing of the reply. Further, a review of the Letter Regarding Suspension makes clear that it is an Office action prepared by the examiner as a result of the examination conducted pursuant to 35 U.S.C. 131. For example, therein the amendment was entered and patentees were advised as all claims were allowable. The Letter Regarding Suspension is a notification under 132 and properly stops the clock for determining examination delay pursuant to 37 CFR 1.702(a)(2).

The patent term adjustment at the time of issuance of the patent is 1260 days (421 (160 + 237 + 24) days of Office delay + 1163 days of over three years delay – 1019 (653 + 105 + 237 + 24) overlapping days + 758 (654 + 105 -1 overlap) days of delay due to interference proceedings – 63 (27 + 36) days of applicant delay).

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136. See 37 CFR 1.323(a)(4).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand two hundred sixty (1260) days**.

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,186,495 B2

DATED : Mar. 6, 2007

DRAFT

INVENTOR(S) : Maeda et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 499 days.

Delete the phrase "by 499 days" and insert – by 1260 days--